

Application No. 09/829,393
Reply to Office Action of August 14, 2006

RECEIVED
CENTRAL FAX CENTER

OCT 13 2006

Remarks

Status of Claims

Claims 1-32 and 34 are pending in the application. All claims have been rejected. Claim 1 and Claim 23 are independent claims.

Claim 4 has been amended to put it in independent form and to set forth the limitations of Claim 1 in it. Claim 23 has been amended for purposes of clarification. Entry of the amendments is respectfully requested. No new matter has been added by these amendments and they should require no additional searching.

Summary of Invention

The subject matter of the present invention relates to a method of obtaining motor vehicle engine oil having characteristics desired by a user via using a wide area computer network to enable the engine oil user or customer to participate in the design, selection or customization of a particular motor oil to fit that customer's specific needs. The method enables a motor oil producer to design, produce, and deliver or make available, an engine oil which fits a particular customer's individual needs by analyzing information provided by the customer. The customer participates in the design, selection or customization of a particular motor oil by providing information used to supply an engine oil with characteristics designed to meet that customer's individual needs.

Claim 1 is directed to:

1. A method of obtaining motor vehicle engine oil having user desired characteristics by using a wide area computer network by:
 - (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
 - (b) analyzing the data by computer; and
 - (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

Application No. 09/829,393
Reply to Office Action of August 14, 2006

wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

According to Claim 1 of the present invention, a wide area computer network site is provided which allows a customer, in one of several ways, to participate in the design, selection or customization of a particular motor oil to fit that customer's individual needs. (specification page 1, lines 14-16). More particularly, data is obtained from the user to identify the user's desired requirements for the motor oil to be obtained. This data may include information about the motor vehicle in which the engine oil is to be utilized as well as information relating to the environment of use, the operational characteristics desired by the customer, ambient temperature, the customer's average driving distance, the user's normal type of driving, and customer interest in fuel economy, cold weather starting, engine longevity and the ability to extend oil drain intervals. The data is analyzed by a computer and an oil is provided to the user which has the characteristics desired by the user.

Claim 4 is directed to:

4. A method of obtaining motor vehicle engine oil having user desired characteristics by using a wide area computer network by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

Application No. 09/829,393
Reply to Office Action of August 14, 2006

Claim 23 provides a method of obtaining custom engine oil by: (a) using an implement to transmit information from a user about the user's motor vehicle type, environment of use, and desired operational characteristics, to a customized blending facility; (b) blending a custom engine oil using the information from (a); and (c) delivering to, installing or making available the custom engine oil blended in step (b) to the user from step (a).

The methods of Claim 1, Claim 4, and Claim 23 permit a motor oil customer to participate in the design, selection or customization of motor oil which has characteristics desired by the motor oil user.

35 USC § 103 Rejections

Claim 1 and 2 were rejected under 35 USC 103(a) as being unpatentable over the anonymous article "Ford Issues Car Care Alert" ("Ford") in view of Osborn et al. (U. S. Patent 6,182,048).

The Examiner has the burden of establishing a prima facie case of obviousness. In order to establish obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. (see, MPEP 706.02(j)).

The Examiner has not established a prima facie case of obviousness because the prior art does not teach or suggest all of the claim limitations since

- 1) none of the references teach or suggest providing motor oil having user desired characteristics for an individual consumer by analyzing information provided by the consumer, thus allow the customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs;
- 2) there is no suggestion or motivation to modify the Ford reference to analyze motor vehicle information by computer since Ford does not address providing motor oil for an individual but is merely a news article with suggestions on winter car care, one of which is that motorists use a certain weight oil in winter;
- 3)

Application No. 09/829,393
Reply to Office Action of August 14, 2006

there is nothing in Ford that would suggest analyzing data in order to provide a motor oil to meet a particular consumer's desires based on a computer analysis of data input by the individual consumer.

Ford lacks all of the elements of Claim 1. Ford does not:

- a) obtain and input data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyze the data obtained from a user by computer; or
- (c) responsive to the analysis of the data provide a motor vehicle engine oil having recommended, or user desired enhancements.

Ford merely advises that motorists use a certain weight of a standard motor oil in cold weather. There is no interaction between the customer and the supplier in which the customer provides information to be used to provide an oil having characteristics desired by the customer. Ford merely provides a suggestion to motorists to use the proper engine oil and says that most manufacturers of vehicles specify 5w-30 oil but that vehicle owners should check their owner guides for specific oil recommendations; however, there is no suggestion in Ford of providing a motor oil to a motorist based on data supplied by the motorist which has been analyzed by computer to enable the provider to provide a motor oil with characteristics designed for that particular user.

Osborn is not directed to motor oils at all. Osborn is directed to a system and method for providing risk-based pricing for vehicle warranties. Osborn is gathering data in order to enhance the profit on warranties being sold by determining what a profitable price will be. Osborn may collect data about the vehicle to be covered by the warranty but it is for the purpose of analyzing risk to Osborn but for determining the price a seller of warranties will charge to make the profit it wants and not for providing a custom motor oil for the car. Osborn may collect data but not for the purpose of allowing the consumer to design his own motor oil or his own warranty. Osborn does not provide the customer with

Application No. 09/829,393
Reply to Office Action of August 14, 2006

any choices. Everything Osborn does is primarily for the benefit of the warranty seller, not for the benefit of the car owner. The Osborn seller of warranties is gathering information in order to fix a profitable price which the seller will charge the customer for a warranty.

The Examiner relies on Osborn to argue that step (b) of Applicants' Claim 1 is obvious. As mentioned previously, Osborn is directed to a system and method for providing risk-based pricing for vehicle warranties. The Examiner relies on Osborn as evidence that data related to vehicles is collected and analyzed by computer. Osborn does not collect data for the purpose of allowing the consumer to design his own motor oil or even his own warranty. The invention must be considered as a whole and cannot be found obvious because the Examiner claims that individual steps, similar to those in the claimed invention, may be known. At the time the present invention was made, it was not known or obvious to obtain data from consumers to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs. Ford does not deal with providing motor oil to a user at all, and neither does Osborn.

Ford and Osborn together do not teach or suggest all limitations of Claims 1 and 2. Neither Ford nor Osborn suggests a method for permitting a consumer to obtain motor vehicle engine oil having characteristics desired by the consumer by using a wide area computer network by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

Application No. 09/829,393
Reply to Office Action of August 14, 2006

The fact that computers can do calculations would not suggest to someone to combine Ford and Osborn without using hindsight with applicant's specification before him.

A prima facie case of obviousness has not been made as Ford and Osborn together do not teach or suggest all limitations of Claims 1 and 2.

Claim 3 was rejected under 35 USC 103(a) as being unpatentable over Ford and Osborn as applied to claim 1 and further in view of Wilkinson ("Understanding What's in your Car's Motor Oil").

The Examiner states that Wilkinson was relied upon for the teaching using different motor oils depending on weather conditions, etc., making it obvious in view of the other references to input information including at least one of expected ambient temperatures, average driving distance, normal type of driving, and interesting fuel economy, cold weather starting, and engine longevity.

For the reasons stated previously Applicants submit that Ford and Osborn together do not teach or suggest all limitations of Claim 3 as neither Ford nor Osborn suggests a method for obtaining motor vehicle engine oil which includes permitting a consumer to participate in the design, selection or customization of a motor oil to fit that consumer's needs by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

Wilkinson merely describes some characteristics of known motor oils with regard to cold temperature performance. Wilkinson does not describe analyzing data input by a consumer or providing a motor oil with user desired

Application No. 09/829,393

Reply to Office Action of August 14, 2006

characteristics based on such data and, as stated above, Osborn is not directed to motor oils at all and neither Osborn nor Ford suggest providing custom motor oils. Osborn may collect data but not for the purpose of allowing the consumer to design his own motor oil or his own warranty. The data is collected for Osborn's benefit, to enhance the profitability of the warranties.

The invention must be considered as a whole and cannot be found obvious because individual steps may be known. A prima facie case of obviousness has not been made as Ford, Osborn and Wilkinson together do not teach or suggest all the limitations of Claim 3

Claims 4, 5, and 6 were rejected under 35 USC 103(a) as being unpatentable over Ford and Osborn as applied to claim 1 and further in view of Klepacki ("Reflect to Mirror Users"). Claim 4 has been amended to put it in independent form and to incorporate the provisions of Claim 1.

Klepacki relates to cosmetics, skin care, and hair care products not to motor oils. There is no mention of "lubrication needs" in Klepacki, and Applicants do not agree with the Examiner's contention that Klepacki is analogous art.

For the reasons stated previously Applicants submit that Ford and Osborn together do not teach or suggest all limitations of Claims 4, 5 and 6 as neither Ford nor Osborn suggests a method for permitting a consumer to participate in the design of a customized motor oil to fit that consumer's needs by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in the

Application No. 09/829,393
Reply to Office Action of August 14, 2006

design, selection or customization of a particular motor oil to fit that customer's needs.

Klepacki relates to cosmetics, not motor oil. Klepacki does not teach or suggest a method for permitting a consumer to participate in the design, selection or customization of a customized motor oil to fit that consumer's particular needs. Neither Ford nor Osborn alone or in combination with Klepacki suggests a method for obtaining motor vehicle engine oil which includes permitting a consumer to participate in the design, selection or customization of a customized motor oil to fit that consumer's needs:

Without having applicant's specification before him, one would not be motivated to combine Klepacki with Ford and Osborn to reconstruct Applicant's claimed invention. Since there is no motivation to combine these references it is submitted that the Examiner is clearly using hindsight to hunt and peck among various references using Applicant's specification as a blueprint in an attempt to reconstruct Applicants' invention from isolated pieces of the prior art.

The motivation for combining references must come from the prior art, not applicant's specification. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." In re Lee, 277 F.3d at 1343, citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). See In re Dow Chem. Co., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-32 (Fed. Cir. 1988) ("[t]here must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure"). Using an applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate of § 103 which requires judging obviousness at the point in time when the invention was made. See Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

Application No. 09/829,393
Reply to Office Action of August 14, 2006

The invention must be considered as a whole and cannot be found obvious because individual steps may be known. A prima facie case of obviousness has not been made as Ford, Osborn, and Klepacki together do not teach or suggest all limitations of Claims 4, 5 and 6.

Claim 7 was rejected under 35 USC 103(a) as being unpatentable over Ford, Osborn, and Klepacki as applied to claim 6 and further in view of official notice. Official notice is taken that it is well known to display advertising indicia on computer screens.

The Examiner argues that it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicants' invention to display on the computer screen indicia indicating the ability of the user to order other automotive products, for the obvious advantage of profiting from the sale of automotive products to persons likely to be interested in buying them.

Ford is merely a news article providing advice on winter car care. Ford does not describe analyzing data input by a consumer or providing a customized motor oil based on such data and, as stated previously, neither Klepacki nor Osborn relates to motor oils. There is no suggestion in Klepacki or Osborn of permitting a consumer to participate in the design, selection or customization of a customized motor oil and there would be no motivation to combine Klepacki, which relates solely to cosmetics, with Ford and Osborn in an attempt to reconstruct Applicant's claimed invention. Moreover, while it may be known to display advertising indicia on computer screens, it was not known or obvious at the time the present invention was made to obtain data from consumers to permit them to participate in the design, selection or customization of a motor oil to fit their individual needs. The invention must be considered as a whole and cannot be found obvious because individual steps may be known. Ford, Osborn, and Klepacki, together with the Examiner's official notice do not teach or suggest all limitations of Claim 7, and, therefore, a prima facie case of obviousness has not been made.

Application No. 09/829,393
Reply to Office Action of August 14, 2006

Claims 8-12, 14, 15, 16, 21, and 22 were rejected under 35 USC 103(a) as being unpatentable over Ford, Osborn, and Klepacki as applied to claim 4 and further in view of Denis.

With regard to Ford, it is Applicants' position that Ford does not pertain to custom blended oil but is merely a winter car care news items which suggests the use of a certain weight oil in winter which may be any known oil available from any company. Ford does no more than provide a suggestion to motorists to use the proper engine oil and says that most manufacturers of vehicles specify 5w-30 oil but that vehicle owners should check their owner guides for specific recommendations. There is no suggestion in Ford of customizing an oil to impart characteristics desired by a particular user who had supplied data to provide the basis for designing a customized motor oil for that particular user.

Denis does not teach a "customized motor oil," but an over-based salt additive for crankcase oils. The consumer may not tailor the crankcase oil of Denis to suit his individual needs. Denis merely describes a fully blended crankcase oil with a slate of additives. The present applicants are not claiming the composition of the motor oil but a method of obtaining a customized motor oil to suit a specific consumer's needs.

Osborn relates to automobile warranties. Klepacki relates to cosmetics. Neither Osborn nor Klepacki relates to motor oils. Ford merely provides advice to motorists to choose the proper weight oil for winter. None of the cited references alone or in combination disclose:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in the

Application No. 09/829,393

Reply to Office Action of August 14, 2006

design, selection or customization of a particular motor oil to fit that customer's needs.

Thus, Ford, Osborn, Klepacki and Denis together do not teach or suggest all limitations of Claims 8-12, and, therefore, a prima facie case of obviousness has not been made.

With regard to Claims 14, 15, 16, and 21 the Examiner argues that, regarding claim 14, Denis teaches in Example III providing a absolute increase of from about 0.1-10% in at least on selected from the group consisting of fuel economy additives, antiwear additives, detergent additives, dispersant additives, oxidation control additives, corrosion inhibitors, pour point depressants and blend stability additives and that it would have been obvious to practice step (c) of Applicants' claimed invention to add additives as listed for the advantages of producing increased fuel economy, reduced wear, etc. The Examiner advances similar arguments regarding Claim 15, saying that Denis teaches adding additives to motor oils to produce two or more enhanced features, regarding Claim 16, that Denis teaches adding additives leading to at least three of said enhanced features. Regarding Claim 21, the Examiner argues that while Denis does not expressly disclose that (c) is practiced do to change at least one of detergent and dispersant concentration levels over the range from about -50% to about +200% compared to their concentration levels in a quality baseline motor oil, Denis does teach that "a basic nitrogen containing dispersant" can vary from 1 to 15 weight percent and that "a detergent in the form of an overbased calcium sulfonate" from 0.2 to 3 weight percent and that it would have been obvious to practice Applicants' step (c) to change at least one of detergent and dispersant concentration levels over the range from about -50% to about +200% compared to their concentration levels in a quality baseline motor oil to produce a customized engine oil having desired properties.

The Examiner cites Denis to demonstrate that a variety of additives are known and are used in varying concentrations to obtain different properties in a motor oil; however, the fact that motor oils can contain additives which provide

Application No. 09/829,393
Reply to Office Action of August 14, 2006

certain properties is not relevant to an analysis of the claimed invention. The present invention is not claiming the composition of the motor oil, but the method of obtaining a customized motor oil to suit a consumer's needs. The invention described and claimed in the present application is directed to a method of doing business. The method permits the direct involvement of the consumer when designing a motor oil to suit that particular consumer's individual needs. This business method is not obvious.

As stated previously, Osborn relates to automobile warranties. Klepacki relates to cosmetics. Neither Osborn nor Klepacki relates to motor oils. Ford merely provides advice to motorists to choose the proper weight standard oil for winter. None of the cited references alone or in combination disclose:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

Thus, Ford, Osborn, Klepacki and Denis together do not teach or suggest all limitations of Claims 14, 15, 16, and 21, and, therefore, a prima facie case of obviousness has not been made.

Claim 13 was rejected under 35 USC 103(a) as being unpatentable over Ford, Osborn, Klepacki and Denis as applied to claims 8-12 and further in view of official notice that the effects of many additives are, within a range, dependent on concentration. The Examiner admits that neither Ford nor Denis discloses that (c) is practiced to provide about 0.1 -100% improvement in at least one of fuel economy, wear performance, detergent performance, dispersant

Application No. 09/829,393

Reply to Office Action of August 14, 2006

performance, oxidation protection corrosion protection, low temperature performance and blend stability, but that Denis teaches additives to improve these characteristics. The Examiner then takes official notice that the effects of many additives are, within a range, dependent on concentration, so that, even if the improvement were over 100% under some circumstances, a lower concentration would produce an improvement of less than 100% – and indeed, it might be that no concentration of an additive would improve performance by more than 100% over a baseline oil and argues that it would have been obvious to practice (c) to provide about 0.1-100% improvement in at least one of the listed characteristics as a consequence of adding desirable additives as taught by Denis.

With regard to the Examiner's taking of official notice that the effects of many additives are, within a range, dependent on concentration, Applicants do not agree that the Examiner's statements of "common knowledge" or "well-known in the art" are in fact prior art. The Examiner relies heavily and improperly on official notice of "common knowledge" or "well-known prior art" to fill the gaps in his argument in an attempt to create a prima facie case of obviousness; however, the Examiner does not provide evidentiary support for such arguments. The articles recited by the Examiner to support the official notice that the effects of many additives are, within a range, dependent on concentration do not even relate to additives to engine oil. Marti relates to the use of phyto-additive ingredients, which are herbal and plant extracts, in cosmetics. Zambiasi does not even relate to additives but describes the role of endogenous lipid components on vegetable oil stability. Lustig relates to a building material additive comprising a dispersion of a hydro-phobic substance completely wetted by a surfactant, and a water-soluble polymer, and Kay relates to an accelerator used to increase the vulcanization rate of rubber. None of these support the Examiner's contention that the effects of many additives are, within a range, dependent on concentration in relation to the subject matter of the present invention.

Application No. 09/829,393

Reply to Office Action of August 14, 2006

Applicants request that the Examiner produce a proper authority for "taking official notice that the effects of many motor oil additives are, within a range, dependent on concentration, so that, even if the improvement were over 100% under some circumstances, a lower concentration would produce an improvement of less than 100% -- and indeed, it might be that no concentration of an additive would improve performance by more than 100% over a baseline oil and argues that it would have been obvious to practice (c) to provide about 0.1-100% improvement in at least one of the listed characteristics as a consequence of adding desirable additives as taught by Denis."

The invention must be considered as a whole. For the reasons stated above in the discussion of Claims 14, 15, 16, and 21, Applicants submit that Ford, Osborn, Klepacki and Denis, even together with the Examiner's official notice, do not teach or suggest all limitations of Claim 13, and, therefore, a prima facie case of obviousness has not been made.

Claims 17, 18, 19, and 20 were rejected under 35 USC 103(a) as being unpatentable over Ford, Osborn, Klepacki and Denis as applied to claim 15 in the case of claims 17 and 19 and to claim 16 in the case of claims 18 and 20 and further in view of official notice.

As discussed previously Ford does not pertain to custom blended oil, but merely advises the use of a proper weight standard oil in winter.

Osborn does not relate to motor oils at all but to a system and method for providing risk-based pricing for vehicle warranties and any data collected about a vehicle is for the purpose of analyzing risk and pricing warranties, not for the purpose of allowing a consumer to make choices to design his own motor.

Denis does not teach a "customized motor oil," but an over-based salt additive for crankcase oils, and while Dennis may show that additives are known and are used to obtain different properties in a motor oil, that is not relevant to an analysis of the claimed invention, which is a not a motor oil but a method for permitting a consumer to participate in the design of a customized motor oil.

Application No. 09/829,393
Reply to Office Action of August 14, 2006

Klepacki does not relate to motor oils at all, but is directed to an e-commerce cosmetics site wherein cosmetics and hair care products can be made to order based on an individual's preferences. There is no suggestion in Klepacki of permitting a consumer to participate in the design of a customized motor oil and there would be no motivation to combine Klepacki with Ford and Osborn in an attempt to reconstruct Applicant's claimed invention without using hindsight, which is clearly impermissible.

The official notice taken with regard to Claims 17, 18, 19, and 20 is the same as that applied for Claim 13, that the effects of many additives are, within a range, dependent on concentration, and, for the reasons given previously, Applicants submit that this is not supported by the references cited by the Examiner and request that the Examiner provide proper authority for the official notice.

Since there is no motivation to combine "Ford", Osborn, Klepacki and Denis as well as the official notice that the effects of many additives are dependent on concentration, it is submitted that the Examiner is clearly using hindsight to hunt and peck among various references using Applicant's specification as a blueprint in an attempt to reconstruct Applicants' invention from isolated pieces of the prior art. It is well established that such use of hindsight is impermissible.

The invention must be considered as a whole. For the reasons stated above in the discussion of Claims 13, 14, 15, 16, and 21, Applicants submit that Ford, Osborn, Klepacki and Denis, together with the Examiner's official notice, do not teach or suggest all limitations of Claims 17, 18, 19, and 20. Therefore, a prima facie case of obviousness has not been made.

Claim 34 was rejected under 35 USC 103(a) as being unpatentable over Ford and Osborn as applied to claim 1 and further in view of the disclosure in the present application at page 2, lines 13-24 that there are accepted industry standard practices outlined in codes introduced by industry organizations such a

Application No. 09/829,393
Reply to Office Action of August 14, 2006

the American Chemistry Council and the Technical Committee of Petroleum Additive Manufacturers in Europe.

The Examiner argues that it would have been obvious to practice (a) –(c) using formulation guidelines or computer models to maintain industry performance credentials of the customized engine oil.

Applicants respectfully traverse this rejection. As pointed out above, the invention must be considered as a whole and cannot be found obvious because individual steps may be known. Neither Ford nor Osborn suggests a method for permitting a consumer to obtain motor vehicle engine oil having characteristics desired by the consumer by using a wide area computer network by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

For the reasons stated above, Ford and Osborn, together with the disclosure in the present application that accepted industry standards exist, do not teach or suggest all the limitations of Claim 34. Therefore, a prima facie case of obviousness has not been made.

Claims 23, 24, 25, and 26 were rejected under 35 USC 103(a) as being unpatentable over Klepacki in view of Wilkinson, the anonymous article "Drive Green Tips" and official notice.

As stated previously, Klepacki does not relate to motor oils at all but to cosmetics and hair care products.

Wilkinson merely describes some characteristics of known motor oils with regard to cold temperature performance. Wilkinson does not describe analyzing

Application No. 09/829,393

Reply to Office Action of August 14, 2006

data input by a consumer or providing a customized motor oil based on such data, and the anonymous article "Drive Green Tips" merely advises vehicle owners that if their Owner's Guide recommends 5w-30 motor oil, they should use it on a regular basis and states that they should follow the manufacturers recommendations for scheduled oil changes. The oil could be any standard 5w-30 motor oil available off the shelf in a store, including a standard "high-quality" oil. Neither Wilkinson nor "Drive Green Tips" suggests a method of obtaining a custom engine oil which permits a consumer to participate in the design of a customized motor oil having operational characteristics desired by that consumer. Nor does Klepacki, which does not even relate to engine oils, suggest a method of obtaining a custom engine oil which permits a consumer to participate in the design of a customized engine oil to fit that consumer's particular needs.

The Examiner notes that Klepacki does not expressly disclose delivering to, installing, or making available for pickup by a use a custom product, but takes official notice that it is well known for e-commerce websites to deliver or make available products ordered by users. Even if that were the case, The invention must be considered as a whole and cannot be found obvious because individual steps may be known.

Furthermore, the Examiner does not provide any evidence to support the taking of official notice that it is well known for e-commerce websites to deliver or make available products ordered by users. Applicants request that the examiner produce authority for his statement. If the information relied upon by the Examiner is in fact common knowledge then the Examiner should provide evidentiary support for such arguments.

Klepacki does not even relate to engine oil, and there is no suggestion in Klepacki of permitting a consumer to participate in the design of a customized engine oil. There would be no motivation to combine Klepacki, which does not relate to engine oils, with Wilkinson and "Drive Green Tips" in an attempt to reconstruct Applicant's claimed invention. Since there is no motivation to

Application No. 09/829,393
Reply to Office Action of August 14, 2006

combine these references it is submitted that the Examiner is clearly using hindsight to hunt and peck among various references using Applicant's specification as a blueprint in an attempt to reconstruct Applicants' invention from isolated pieces of the prior art which is impermissible.

Klepacki, Wilkinson, the anonymous article "Drive Green Tips" together with the Examiner's official notice that e-commerce websites deliver or make available products ordered by users do not teach or suggest a method of obtaining custom engine oil by:

- (a) using an implement to transmit information from a user about the user's motor vehicle type, environment of use, and desired operational characteristics, to a customized blending facility;
- (b) blending a custom engine oil using the information from (a); and
- (c) delivering to, installing or making available for pickup by the user from step (a) the custom engine oil blended in step (b).

Klepacki, Wilkinson, the anonymous article "Drive Green Tips" together with the Examiner's official notice that e-commerce websites deliver or make available products ordered by users do not teach or suggest all the limitations of Claim 23. Therefore, a prima facie case of obviousness has not been made.

With regard to the rejection of Claims 24, 25, and 26, Applicants again point out that the invention must be considered as a whole and cannot be found obvious because individual steps may be known. For the reasons stated above in relation to Claim 23, Klepacki, Wilkinson, the anonymous article "Drive Green Tips" together with the Examiner's official notice that e-commerce websites deliver or make available products ordered by users do not teach or suggest all the limitations of Claims 24, 25, and 26. Nothing in them alone or in combination suggests a method of obtaining custom engine oil which permits a consumer to participate in the design of a customized engine oil which is blended to fit that particular consumer's needs based on information provided by the customer. Therefore, a prima facie case of obviousness has not been made.

Application No. 09/829,393
Reply to Office Action of August 14, 2006

Claims 27-32 were rejected under 35 USC 103(a) as being unpatentable over Klepacki in view of Wilkinson, "Drive Green Tips" and official notice applied to Claim 23 above and further in view of Denis et al. (U.S. Patent 4,954,273).

As discussed previously, the Examiner provides no evidentiary support for the taking of official notice that it is well known for e-commerce websites to deliver or make available products ordered by users.

The Examiner admits that neither Klepacki nor Wilkinson discloses that blending a custom engine oils is practiced to add additives leading to at least two or more enhanced features selected from enhanced wear protection, enhanced fuel economy, enhanced detergency, enhanced dispersancy, enhanced low temperature startability, enhanced high temperature viscosity, extended drain capability, enhanced wear protection, corrosion protection, enhanced control of oxidation and enhanced blend stability, but argues that Denis teaches adding additives to enhance two or more of these features in Fully Formed Example III and that it would have been obvious to practice (b) to add additives leading to at least two or more of the listed enhanced features.

Denis does not teach a "customized motor oil," but an over-based salt additive for crankcase oils. The Examiner cites Denis to demonstrate that a variety of additives are known and are used to obtain different properties in a motor oil, but that is not relevant to an analysis of the claimed invention. The present invention is not claiming the composition of the motor oil, but the method of obtaining a customized motor oil to suit a particular consumer's needs. The consumer may not tailor the crankcase oil of Denis to suit his individual needs. Denis merely describes a fully blended crankcase oil with a slate of additives. Nothing in Denis suggests a method of obtaining a customized motor oil to suit a specific consumer's needs.

The invention must be considered as a whole and cannot be found obvious because individual steps may be known. For the reasons stated previously in responding to the rejection of Claims 23-26, Klepacki, Wilkinson, the anonymous article "Drive Green Tips" together with the Examiner's official

Application No. 09/829,393
Reply to Office Action of August 14, 2006

notice that e-commerce websites deliver or make available products ordered by users do not teach or suggest all the limitations of Claims 27-32. Nothing in them alone or in combination with Denis suggests a method of obtaining custom engine oil by: (a) using an implement to transmit information from a user about the user's motor vehicle type, environment of use, and desired operational characteristics, to a customized blending facility; (b) blending a custom engine oil using the information from (a); and (c) delivering to, installing or making available for pickup by the user from step (a) the custom engine oil blended in step (b). Therefore, a prima facie case of obviousness has not been made.


In conclusion, the Examiner failed to establish a prima facie case of obviousness because the references do not teach or suggest all of the claim limitations. When Applicants' claimed invention is considered as a whole, it is not obvious in view of the references combined and applied by the Examiner.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. Reconsideration, allowance of all claims, and passage of the application to issue are respectfully requested.

If the Examiner believes an oral or telephonic interview would advance the prosecution of this case, the Examiner is encouraged to contact Applicants' attorney at the Examiner's convenience.

Correspondence Address:
BP America Inc.
Docket Clerk, BP Legal, M.C. 5East
4101 Winfield Road
Warrenville, Illinois 60555
Customer No. 04249

Respectfully submitted,


Mary Jo Kanady
Attorney for the Applicant(s)
Registration Number 28,623
(630) 821-2458